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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/450,757 | 11/30/1999 | HIROTAKA ISHII | 040281-0118 | 8146 |
| 7590 | 12/31/2003 | | EXAMINER | |
| FOLEY & LARDNER WASHINGTON HARBOUR 3000 K STREET NW SUITE 500 WASHINGTON, DC 200075109 | | | KIBLER, VIRGINIA M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2623 | |
| | | | DATE MAILED: 12/31/2003 | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/450,757 | ISHII ET AL. | |
| | Examiner | Art Unit | |
| | Virginia M Kibler | 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-11 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment received on 10/7/03 has been entered. Claims 1 and 3-11 remain pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by DiMaria (5,995,014).

Regarding claims 1 and 10, DiMaria discloses a fingerprint reader unit 14 (Figure 4) to input a fingerprint to be detected (Col. 4, lines 45-51), a database unit 30 to record a fingerprint database provided in advance, a fingerprint comparing unit 20 that identifies the input fingerprint input by the fingerprint reader unit by comparing with fingerprints stored in the fingerprint database recorded in the database unit (Col. 4, lines 45-63), and a user recording unit that automatically records the fingerprint input by the fingerprint reader unit wherein the user recording unit records the input fingerprint only when the fingerprint comparing unit does not identify the input fingerprint (Col. 4, lines 64-67, Col. 5, lines 1-20).

Regarding claim 3, DiMaria discloses the user recording unit records the input fingerprint transmitted from the fingerprint reader unit, and the transmitted input fingerprint includes a raw data of the input fingerprint (Col. 4, lines 52-63).

Regarding claim 4, DiMaria discloses an image data processing unit to process the input fingerprint (Col. 4, lines 45-51).

Regarding claim 5, DiMaria discloses the user recording unit records the input fingerprint transmitted from the image processing unit, and the transmitted input fingerprint includes processed data of the input fingerprint (Col. 4, lines 52-63).

Regarding claim 9, DiMaria discloses the device is used for access control (Abstract).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiMaria (5,995,014) as applied to claim 1 above, and further in view of DiMaria et al. (5,959,541).

Regarding claim 8, DiMaria discloses generating a report including time (Col. 4, lines 64-67, Col. 5, lines 1-4), but does not expressly state a date counter. However, DiMaria et al. (5,959,541) teaches that it is known to include a date counter that provides a date record used to generate a recording history (Col. 4, lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the report disclosed by

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DiMaria to include a date counter, as taught by DiMaria et al. (5,959,541), because it is well known in the art and provides a more detailed record for access control.

6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMaria (5,995,014) as applied to claim 1 above, and further in view of Jain et al. (6,185,318).

Regarding claims 6 and 7, DiMaria does not recognize including a feature extraction unit to extract a feature count from the input fingerprint. However, Jain teaches that it is known to include a feature extraction 220 unit to extract a feature count from the input fingerprint (Figure 2). Jain further teaches that it is known to compress attribute or “feature” data (Col. 15, lines 14-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the fingerprint data disclosed by DiMaria to include a feature extraction unit resulting in compact data size, as taught by Jain, because it is well known in the art to extract feature count for authentication or identification purposes and the compact data size provides increased storage capacity.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiMaria (5,995,014) as applied to claim 11 above, and further in view of Levison et al. (5,465,303).

Regarding claim 11, the arguments analogous to those presented above for claim 1 are applicable to claim 11. DiMaria does not appear to expressly state temporarily storing the input fingerprint. However, Levison et al. (“Levison”) teaches that it is known to temporarily store the input fingerprint to be detected (Col. 22, lines 1-6) and record the input fingerprint in the permanent user recording unit from the temporarily stored fingerprint only when the input fingerprint to be detected does not match any of the reference fingerprints in the database (Col. 25, lines 6-10). Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified the storing of the input fingerprint disclosed by DiMaria to include the temporary storage as taught by Levison because it is well known and routinely implemented in the art in order to minimize the storage requirements.

Response to Arguments

8. Applicant's arguments with respect to claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia M Kibler whose telephone number is (703) 306-4072. The examiner can normally be reached on Mon-Thurs 8:00 - 5:30 and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

VK

12/19/03

**MEHRDAD DASTOURI
PRIMARY EXAMINER**

Mehrdad Dastouri